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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,155	11/19/2001	Jean Sini	19111.0059	8154
23517	7590	07/21/2006	EXAMINER	
BINGHAM MCCUTCHEN LLP			THAI, HANH B	
3000 K STREET, NW			ART UNIT	
BOX IP			PAPER NUMBER	
WASHINGTON, DC 20007			2163	

DATE MAILED: 07/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/988,155

Applicant(s)

SINI, JEAN

Examiner

Hanh B. Thai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on RCE filed 6/27/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 10-12, 14, 19-21, 23 and 28-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 10-12, 14, 19-21, 23 and 28-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following is a Non-Final Office Action in response to the RCE filed June 27, 2006. Independent claims 1, 10 and 19 have been amended. Claims 4, 6-9, 13, 15-18, 22 and 24-27 have been cancelled. Claims 28-30 are newly added. Claims 1-3, 5, 10-12, 14, 19-21, 23 and 28-30 are now pending in this application.

Response to Arguments

2. Applicant's arguments regarding "creating a mapping for the form that specifies how to fill-in the form into which store information is to be entered based on the information received selection of information for the form" have been fully considered but they are not persuasive.

Steed clearly discloses the mapping the fields of the forms ([0009] and [0023]) based on the merchant and user details information and automatically fill-in the form (abstract; summary). Therefore, this teaching still reads on the claimed limitation of "a mapping for the form based on the information received selection of information for the form" and it is inherently specifies how to fill-in fields in the form.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 28-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed

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invention. Applicant did not point out where in the specification discloses “the information retrieved to enter into the at least one field of form is stored in a location specifically associated with the form and the field.”

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-3, 5, 10-12, 14, 19-21, 23 and 28-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 10 and 19 recite “the entered information”, “stored information” and “received at least one selection of information”. The scope of the claims can not be determined.

Furthermore, it is not clear which information to be stored and entered from the user of the mobile device.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 5, 10-12, 14, 19-21, 23 and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steed et al. (US Pub. No. 2002/0107755) of record in view of Chinn et al. (US Pub. 2002/0010715 A1) newly cited reference.

Regarding claims 1, 10 and 19, Steed discloses a method for automatically entering information into form fields (abstract of Steed) comprising the steps of:

- invoking a application program in response to an indication from a user of a mobile device to do so (see abstract and summary of Steed);
- scanning content transmitted from the application program to the mobile device to find a form having at least one field into which information is to entered (see ¶ [0008]; ¶ [0012]; ¶ [0013]; ¶ [0031] to ¶ [0039] and ¶ [0043]);
- retrieving and entering information to enter into the at least one field (see [0023] to [0026] and [0044], Steed) and transmitting the form including the entered information to the mobile device for display to the user (¶ [0008]; ¶ [0012]; ¶ [0026]; ¶ [0031] to ¶ [0039] and ¶ [0043]), if the mapping for the form exists ([0009]);

Steed discloses a mapping for the form ([0009]). The claim 1 is overall rejected under “a mapping” scenario, since the “if no mapping” condition is no longer required once mapping already occurred.

Steed, however, does not disclose creating a mapping for the form if no mappings for the form exist. Chinn, on the other hand, discloses a method for browsing using a limited display device including creating a mapping for a form (summary and ¶ [0113], Chinn). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Steed to include the claimed feature as taught by Chinn. The motivation of doing so would have been desirable to efficiently access content stored on communication networks using limited display devices (¶ [0005], Chinn).

Regarding claims 2, 11 and 20, Steed/Chinn combination further discloses the receiving at least one edit made by the user of the mobile device of the entered information; and transmitting the form including the edited entered information to the application program (see ¶ [0013] and ¶ [0026], Steed). Further, it is inherent for a computer navigator to offer a user the ability to easily edit a display on screen. This ability has in large been the driving force behind the almost universal adoption of the computer as the preferred means of data entry via filling out a form.

Regarding claims 3, 12 and 21, Steed/Chinn combination further discloses the mapping for the form comprises information mapping at least one field of the form into which information is to be entered to stored information (see ¶ [0009], Steed).

Regarding claims 5, 14 and 23, Steed/Chinn combination further discloses the updating information mapping at least one field of the form into which information is to be entered to stored information based on the received selection of information made by the user, if the entered information was edited by the user (see ¶ [0021] and ¶ [0022], Steed).

Regarding claims 28-30, Steed/Chinn combination discloses wherein the information retrieved to enter into the at least one field of the form is stored in a location specifically associated with the form and the field (see ¶ [0044], Steed).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sugiura et al. (US 6,362,783 B1) disclose wireless communication system and method for detection of position of radio mobile station.

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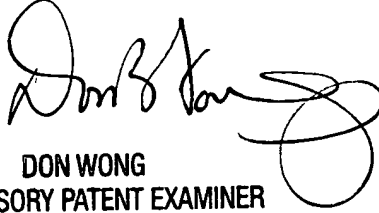
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hanh B. Thai whose telephone number is 571-272-4029. The examiner can normally be reached on 8 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hanh B Thai
Examiner
Art Unit 2163

July 5, 2006


DON WONG
SUPERVISORY PATENT EXAMINER
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